

REMARKS

Status of Claims:

Claims 1-10 are present for examination:

Prior Art Rejection:

Claims 1-10 stand rejected under 35 USC 103 as unpatentable over Nakamura (6,342,933) in view of Uchida (6137548), further in view of Kajiwara (5,801,542) and further in view of Iwamoto (5,710,607).

The Examiner recognizes that the primary reference of Nakamura does not disclose three of the key limitations set forth in applicant's claim 1 as explained in Applicant's prior amendments filed October 15, 2003 and February 3, 2004. These three key limitations are (1) the holding/engaging structure, (2) the depression/recess structure and (3) the deformable/elastic structure. The Examiner then points to three completely different structures to isolate each of the three limitations separately within particular disparate structures in order to arrive at applicant's claimed invention. The Examiner asserts that Uchida shows the holding/engaging structure; that Kajiwara discloses the depression/recess structure and that Iwamoto discloses the deformable/elastic structure.

The Examiner's rejection is respectfully traversed.

Even if applicant assumes, for the sake of argument, that each of the Uchida, Kajiwara and Iwamoto references disclose the subject matter as claimed by the Examiner, the Patent and Trademark Office still has not made out a prima facie case of obviousness under the provisions of 35 USC 103. There is simply no motivation within these references to combine them in a manner suggested by the Examiner. For example, what would motivate one to change the structure of Nakamura in order to have the pressing portion 17a make direct contact with the convex portion 11a (Nakamura figure 1). Assuming this were done, how would the driving circuit substrate 12 actually be held in place? Similar problems exist in combining the other references in some unknown manner by completely rearranging the

structure disclosed so as to somehow incorporate the limitations of all three patents into a single embodiment.

It might be helpful if the Examiner appreciated that the prior art, to the extent that elastic or deformable members are utilized, configures these elastic and deformable members to make direct contact with the circuit board or LCD panel which is desired to be secured. In contrast, applicant's invention utilizes the deformable member as part of or as a member in between the two holding members. Thus, the deformable members do not make contact with the LCD panel itself, but rather make contact with the frame or holding member – and herein lies a key distinction over the prior art. Of course, applicant's claim, taken as a whole, requires all of the limitations to be found or made obvious by the prior art, including the limitations wherein the two holding members engage each other, the limitation that at least one of the holding members has a depression that engages the LCD panel at its periphery and a limitation that at least one of the holding members engages the other of the holding members by means of an elastically deformable material.

Absent some motivation to combine, motivation found within the teachings of the prior art references themselves, the Examiner appears to be utilizing mere hindsight reasoning in order to fabricate the section 103 rejection. Applicant is at a complete loss as to what structure one would start with and how one would change that particular structure to insert the elements from the various patents. For example, would one start with the primary Nakamura reference which admittedly fails to disclose either of the three key limitations discussed above and in the prior October 15, 2003 amendment, or does one start with one of the secondary references? Assuming one starts with the primary reference, where is the motivation to change this primary reference in a manner that would incorporate the holding/engaging structure from Uchida, the depression/recess structure from Kajiwara and the deformable/elastic structure from Iwamoto? How exactly would one do this and why? The Examiner can simply not select bits and features from applicant's claims, show that they exist in the prior art and automatically establish a *prima facie* case of obviousness. Indeed, it is submitted that every limitation of a combination claim can be individually found somewhere in the prior art. However, finding them somewhere in the prior art is not the test of obviousness. Rather, the test of obviousness must rely, at least in part, on making

substitutions which make sense and which do not destroy the fundamental structure of the primary reference.

If the Examiner persists in the instant rejection, he is respectfully requested to more particularly define how one would modify a particular starting reference, which elements would be removed, which elements would be replace from another reference and how would they be so replaced, and to particularly point out the motivation within the references themselves to make the substitutions.

Moreover, with regard to Iwamoto, it is not seen how the elastomeric member 115 which is secured to the frame 107 is read upon by applicant's deformable/elastic structure. According to applicant's claim recitation, there must be a first and second holding members and they must make contact with each other. At the point of contact, one of these members must be elastically deformable. If the frame 107 is the first holding member, where is the second holding member shown in Iwamoto? Applicant does note that an rubber type adhesive 114 is applied to the glass structure 102 along the entire periphery thereof, but this adhesive is not the second holding member. Moreover, the upper cover 112 and the protective glass plate can not be the second holding member since these elements do not make contact with the first holding member (frame) 107. Thus, it is not seen how the Iwamoto reference discloses the deformable/elastic structure as claimed by applicant.

Further, with regard to Kajiwara, applicant notes that the depression as recited in applicant's claims is part of at least one of the first and second holding members. It is not seen how any depression in Kajawara meets these claim recitations. If the examiner persist in applying this reference, he is requested to specify which elements of Kajawara correspond to the claim recitations. Indeed this same request is made for each of the references applied. It is not at all clear how the examiner is reading the references and thus particularly pointing out the structure which is alleged to correspond with applicant's claims will greatly assist in expediting prosecution of the application.

Conclusions:

In view of the comments set forth above, it is submitted that applicant's claims are not made obvious over the prior art and that the Patent and Trademark Office has not made out a prima facie case of obviousness under the provisions of 35 USC 103.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

It is submitted that the application is now in condition for allowance and an early indication of same is earnestly solicited.

Respectfully submitted,

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